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| FORM PTO-1390 (REV. 01-2003) | | US DEPARTMENT OF COMMERCE PATENT & TRADEMARK OFFICE | | ATTORNEY'S DOCKET NUMBER 124796 | |
| TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 | | | | U.S. APPLICATION NO. (If known, see 37 CFR 1.5) 10/542,956 | |
| INTERNATIONAL APPLICATION NO. PCT/JP2004/000265 | | INTERNATIONAL FILING DATE January 16, 2004 | | PRIORITY DATE CLAIMED January 21, 2003 | |
| TITLE OF INVENTION THIN FILM CAPACITANCE ELEMENT COMPOSITION, HIGH PERMITTIVITY INSULATION FILM, THIN FILM CAPACITANCE ELEMENT, THIN FILM MULTILAYER CAPACITOR AND PRODUCTION METHOD OF THIN FILM CAPACITANCE ELEMENT | | | | | |
| APPLICANT FOR DO/EO/US Yukio SAKASHITA | | | | | |
| Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information: | | | | | |
| 1. <input type="checkbox"/> This is a FIRST submission of items concerning a filing under 35 U.S.C. 371. | | | | | |
| 2. <input checked="" type="checkbox"/> This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. 371. | | | | | |
| 3. <input type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below. | | | | | |
| 4. <input type="checkbox"/> The US has been elected (Article 31). | | | | | |
| 5. <input type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2)) | | | | | |
| a. <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau). | | | | | |
| b. <input type="checkbox"/> has been communicated by the International Bureau. | | | | | |
| c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US). | | | | | |
| 6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)) | | | | | |
| a. <input type="checkbox"/> is attached hereto. | | | | | |
| b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4). | | | | | |
| c. <input type="checkbox"/> The International Application was filed in English. | | | | | |
| 7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)) | | | | | |
| a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau). | | | | | |
| b. <input type="checkbox"/> have been communicated by the International Bureau. | | | | | |
| c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired. | | | | | |
| d. <input type="checkbox"/> have not been made and will not be made. | | | | | |
| 8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)). | | | | | |
| 9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). | | | | | |
| 10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)). | | | | | |
| Items 11 to 20 below concern document(s) or information included: | | | | | |
| 11. <input checked="" type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98. | | | | | |
| 12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included. | | | | | |
| 13. <input type="checkbox"/> A preliminary amendment. | | | | | |
| 14. <input type="checkbox"/> An Application Data Sheet under 37 CFR 1.76. | | | | | |
| 15. <input type="checkbox"/> A substitute specification. | | | | | |
| 16. <input type="checkbox"/> A power of attorney and/or change of address letter. | | | | | |
| 17. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825. | | | | | |
| 18. <input type="checkbox"/> A second copy of the published international application under 35 U.S.C. 154(d)(4). | | | | | |
| 19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4). | | | | | |
| 20. <input checked="" type="checkbox"/> Other items or information: International Search Report. | | | | | |

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| U.S. APPLICATION NO. (if known, see 37 C.F.R. 1.5) 10/542,956 | | INTERNATIONAL APPLICATION NO. PCT/JP2004/000265 | | ATTORNEY'S DOCKET NUMBER 124796 | |
| 21. <input type="checkbox"/> The following fees are submitted: | | | | CALCULATIONS | |
| | | | | PTO USE ONLY | |
| BASIC NATIONAL FEE (37 CFR 1.492(a)): \$ 300.00 | | | | \$ | |
| SEARCH FEE (37 CFR 1.492(b)(1)-(3)): International preliminary examination report or written opinion prepared by the USPTO as IPEA or ISA and favorable as to novelty, inventive step, and industrial applicability for all claims presented in the application entering the national stage \$ 0.00 International search fee (37 CFR 1.445(a)(2)) paid to USPTO as ISA \$ 100.00 International search report provided to USPTO no later than the time at which the search fee is paid \$ 400.00 All situations not provided for above \$ 500.00 | | | | \$ | |
| EXAMINATION FEE (37 CFR 1.492(c)(1)-(2)): International preliminary examination report or written opinion prepared by the USPTO as IPEA or ISA and favorable as to novelty, inventive step, and industrial applicability for all claims presented in the application entering the national stage \$ 0.00 All situations not provided for above \$ 200.00 | | | | \$ | |
| Surcharge of \$130.00 for furnishing the oath or declaration later than 30 months from the earliest claimed priority date (37 CFR 1.492(e)). | | | | \$ | |
| TOTAL PAGES OF APPLICATION OVER 100 (- 100) | ÷ 50 | = † | x 250 = | \$ | |
| †round up to next integer | | | | | |
| CLAIMS | NUMBER FILED | NUMBER EXTRA | RATE | \$ | |
| TOTAL CLAIMS | - 20 | = | x 50.00 = | \$ | |
| INDEPENDENT CLAIMS | - 3 | = | x 200.00 = | \$ | |
| MULTIPLE DEPENDENT CLAIM(S)(if applicable) | | | + 360.00 = | \$ | |
| TOTAL OF ABOVE CALCULATIONS = | | | | \$ | |
| <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2. | | | | \$ | |
| SUBTOTAL = | | | | \$ | |
| Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(f)). | | | | \$ | |
| TOTAL NATIONAL FEE = | | | | \$ | |
| Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property + | | | | \$ | |
| TOTAL FEES ENCLOSED = | | | | \$ | |
| | | | | Amount to be refunded: | \$ |
| | | | | charged: | \$ |
| a. <input type="checkbox"/> Check No. _____ in the amount of \$ _____ to cover the above fees is enclosed. b. <input type="checkbox"/> Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees. A duplicate copy of this sheet is enclosed. c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 15-0461. A duplicate copy of this sheet is enclosed. d. <input type="checkbox"/> Fees are to be charged to a credit card. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038. | | | | | |
| NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status. | | | | | |
| SEND ALL CORRESPONDENCE TO: OLIFF & BERRIDGE, PLC Customer Number: 25944 | | | | | |
| Date <u>February 10, 2006</u> | | |  NAME: James A. Oliff REGISTRATION NUMBER: 27,075 | | |
| | | | NAME: Randi B. Isaacs REGISTRATION NUMBER: 56,046 | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yukio SAKASHITA

Application No.: 10/542,956

Filed: July 21, 2005

Docket No.: 124796

For: THIN FILM CAPACITANCE ELEMENT COMPOSITION, HIGH PERMITTIVITY
INSULATION FILM, THIN FILM CAPACITANCE ELEMENT, THIN FILM
MULTILAYER CAPACITOR AND PRODUCTION METHOD OF THIN FILM
CAPACITANCE ELEMENT

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR §1.56, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO-1449. Unless otherwise indicated herein, one copy of each reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

- ☒ 1. This Information Disclosure Statement is being filed (a) within three months of the U.S. filing date of this non-CPA application, OR (b) before the mailing date of a first Office Action on the merits in the present application. No certification or fee is required.
- ☒ 2. Relevance of one or more non-English language reference is discussed in the present specification. See References 1-5.
- ☒ 3. One or more reference cited herein was cited in the International Search Report. An English language version of the International Search Report is attached for the Examiner's information. See References 6-9 & 17.
- ☒ 4. An English language Abstract of one or more non-English language reference is attached hereto. See References 2-5 & 7-9.

☒ 5. A computer-generated English language translation of one or more Japanese Patent Publication cited herein has been obtained from the website of the Japanese Patent Office ([<http://www.jpo.go.jp>]), and is attached, but has not been reviewed for accuracy. See References 2-5 & 7-9.

☒ 6. References 7 corresponds to Reference 6.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Randi B. Isaacs
Registration No. 56,046

JAO:RBI/yxm

Date: February 10, 2006

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Telephone: (703) 836-6400

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| <p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p> |
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| Form PTO-1449 (REV. 1/06) | | US Dept. of Commerce PATENT & TRADEMARK OFFICE | | ATTY DOCKET NO. 124796 | | APPLICATION NO. 10/542,956 | |
| INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary) | | | | APPLICANT Yukio SAKASHITA | | | |
| | | | | FILING DATE July 21, 2005 | | | |

| U.S. PATENT DOCUMENTS | | | | | | |
|-----------------------|-------------|-----------------|------|------|--|--|
| Examiner Initials | Cite No. | Document Number | Date | Name | | |
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| FOREIGN PATENT DOCUMENTS | | | | | | |
|--------------------------|-------------|------------------|------------|------------------------|-----------------------------|--------------------------------|
| Examiner Initials | Cite No. | Document Number | Date | Country | With English Abstract | With English Translation |
| | 1 | JP A 56-144523 | 11/10/1981 | JAPAN | | |
| | 2 | JP A 05-335173 | 12/17/1993 | JAPAN | X | X |
| | 3 | JP A 05-335174 | 12/17/1993 | JAPAN | X | X |
| | 4 | JP A 11-214245 | 08/06/1999 | JAPAN | X | X |
| | 5 | JP A 2000-124056 | 04/28/2000 | JAPAN | X | X |
| | 6 | EP 0 877 100 A1 | 11/11/1998 | EUROPEAN PATENT OFFICE | | |
| | 7 | JP A 11-049600 | 02/23/1999 | JAPAN | X | X |
| | 8 | JP A 08-253324 | 10/01/1996 | JAPAN | X | X |
| | 9 | JP A 2002-321974 | 11/08/2002 | JAPAN | X | X |

| OTHER DOCUMENTS | | |
|----------------------|-------------|---|
| Examiner Initials | Cite No. | (Including Author, Title, Date, Pertinent Pages, etc.) |
| | 10 | T. KOJIMA et al., "Novel Candidate of c-axis-oriented BLSF Thin Films for High-Capacitance Condenser," Mat. Res. Soc. Symp. Proc., 2003, Vol. 748, pages 451-456. |
| | 11 | The 27 th Annual Cocoa Beach Conference & Exposition on Advance Ceramics & Composites, 26-31 January 2003 |
| | 12 | The 5 th International Meeting of Pacific Rim Ceramic Societies Incorporating the 16 th Fall Meeting of the Ceramic Society of Japan, 29 September to 2 October 2003, page 35 |
| | 13 | The 5 th International Meeting of Pacific Rim Ceramic Societies Incorporating the 16 th Fall Meeting of the Ceramic Society of Japan, 2003, page 111 |

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| EXAMINER | DATE CONSIDERED |
| Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | |

Date: February 10, 2006

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| Form PTO-1449 (REV. 1/06) | | US Dept. of Commerce PATENT & TRADEMARK OFFICE | | ATTY DOCKET NO. 124796 | | APPLICATION NO. 10/542,956 | |
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| | | | | FILING DATE July 21, 2005 | | | |

| U.S. PATENT DOCUMENTS | | | | |
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| FOREIGN PATENT DOCUMENTS | | | | | | |
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| Examiner Initials | Cite No. | Document Number | Date | Country | With English Abstract | With English Translation |
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| OTHER DOCUMENTS | | |
|----------------------|-------------|--|
| Examiner Initials | Cite No. | (Including Author, Title, Date, Pertinent Pages, etc.) |
| | 14 | MRS 2002 Program Exhibit Guide, 2-6 December 2002, page 211 |
| | 15 | Extended Abstracts (The 50 th Spring Meeting, 2003); The Japan Society of Applied Physics and Related Societies, No. 2, 27-30 March 2003, page 596 |
| | 16 | Extend Abstracts (The 64 th Autumn Meeting, 2003); the Japan Society of Applied Physics, 30 August 2003 to 2 September 2003, No. 2, page 493 |
| | 17 | L. NIBOU et al., Chemical Fabrication SrBi ₄ Ti ₄ O ₁₅ Thin Films, Journal of the European Ceramic Society, 1999, Vol. 19, pages 1383 to 1386 |

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|---|-----------------|
| EXAMINER | DATE CONSIDERED |
| Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | |

Date: February 10, 2006